

Appl. No. 10/716,506

Amendment dated: August 20, 2007

Reply to OA of: May 18, 2007

**REMARKS**

Applicants have amended the claims to more particularly define the invention taking into consideration the outstanding Official Action and the brief telephone conversation with Examiner Tate on August 20, 2007 and the Examiner's proposal to place the application in condition for allowance as discussed with the Examiner on May 1, 2007. Applicants have amended the claims in accordance with the Examiner's proposed amendments to place the application in condition for allowance prior to the issuance of the outstanding Official Action. In this regard, please note the Examiner initiated interview summary of May 1, 2007. Applicants reserve the right to file a continuation application at a later time to any canceled or non-claimed subject matter. Applicants submit that the amendments to the claims is fully supported by the specification as originally filed and no new matter has been introduced. Entry of the amendment is in order as it serves to reduce the issues and places the application in condition for allowance. Applicants most respectfully submit that all of the claims now present in the application are in full compliance with 35 USC 112 and are clearly patentable over the references of record.

The rejection of claims 15 and 16 under 35 U.S.C. 112, first paragraph for the reasons set forth in the previous Official Action has been carefully considered but is most respectfully traversed in view of the cancellation of these claims without prejudice or disclaimer. Accordingly, it is most respectfully requested that this rejection be withdrawn.

Applicants most respectfully submit that all of the claims now present in the application are in full compliance with 35 USC 112 and clearly patentable over the references of record.

The rejection of claims 15 and 16 under 35 USC 102(b) as being anticipated over Castleman for the reasons set forth in the previous Official Action has been carefully considered but is most respectfully traversed in view of the cancellation of these claims from the application in order to place the application in immediate condition for

Appl. No. 10/716,506

Amendment dated: August 20, 2007

Reply to OA of: May 18, 2007

allowance by making the amendments proposed by the Examiner. While applicants will not argue the patentability of these claims in the present application, all rights are reserved to do so in a continuation application.

As previously noted, and as discussed briefly with the Examiner on August 20, 2007, with respect to the meaning of "set of" in amended claim 1, and as would be appreciated by one of ordinary skill in the art, the presently claimed composition includes compositions formed by decocting or otherwise extracting the three named herbs. Note that there are a number of ways to do this as would be appreciated by one of ordinary skill in the art and the present disclosure. One can mix the herbs (actually, the roots (*radix* in Latin) are what is used) and then perform the decoction/extraction on the mixture. Or, one can mix two of the herbs and then perform two decoctions/extractions, one on the mixture and the other on the remaining herb, and then mix the liquors or the dried residues of each procedure. Or, one can perform three separate decoctions/extractions, one on each individual herb, and then mix the liquors or the dried residues of each procedure. There are other more complex variations/permuations, of course, but anyway ultimately they all arrive at the composition. Thus, it is clearly understood there is no requirement that the herbs must be brought together before the decoction/extraction.

The rejection of claims 1-4 and 9-16 under 35 USC 103(a) as being unpatentable over Sheehan et al. and Whittle for the reasons set forth in the previous Official Action has been carefully considered but is most respectfully traversed in view of the amendments to the claims and further in view of the following comments.

Applicants wish to direct the Examiner's attention to the basic requirements of a *prima facie* case of obviousness as set forth in the MPEP § 2143. This section states that to establish a *prima facie* case of obviousness, three basic criteria first must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a

Appl. No. 10/716,506

Amendment dated: August 20, 2007

Reply to OA of: May 18, 2007

reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Section 2143.03 states that all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Applicants also most respectfully direct the Examiner's attention to MPEP § 2144.08 (page 2100-114) wherein it is stated that Office personnel should consider all rebuttal argument and evidence presented by applicant and the citation of *In re Soni* for error in not considering evidence presented in the specification.

As previously noted, the presently claimed invention is the use of a specific three-herb group to make a decoction/extract having beneficial therapeutic efficacy. The decoction/extract can be made via **individual** decoctions/extracts of the stated herbs which are then (or their dried residues) blended to form the active composition, or via decocting/extracting a **mixture** of the stated herbs to yield the active composition directly of the claims.

The **specific three-member** group is, of course, significantly reduced from the prior art ten-member set, and represents one of the specific groups for which essential maintenance of the efficacy in comparison with the ten-member set is proved in Table II of the application and is believed to be allowable in view of the May 1, 2007 interview and proposed Examiner's amendment.

Moreover, it is the case in Chinese (and other) traditional herbal medicine that practitioners are very reluctant to depart from the traditional recipe. This is because the

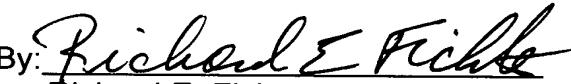
Appl. No. 10/716,506  
Amendment dated: August 20, 2007  
Reply to OA of: May 18, 2007

recipe has evolved by continuous gradual use-based refinement over many years or centuries, and is closely associated with the underlying theoretical basis for the medicine which is quite different from the essentially biochemical basis of western medicine. Traditional medicine generally uses underlying theoretical bases which involve a relatively holistic approach, taking into account mood, personality, general health, life-force and quasi-spiritual aspects.

Applicants submit that it is not obvious to adjust the prior art in the way the present inventors have done, to maintain the efficacy of the composition. This position is confirmed by the prior grant of US Patents 6399112 and 6676975. Accordingly, it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all the claims now present in the application are most respectfully requested.

Respectfully submitted,  
BACON & THOMAS, PLLC

By:   
Richard E. Fichter  
Registration No. 26,382

625 Slaters Lane, Fourth Floor  
Alexandria, Virginia 22314  
Phone: (703) 683-0500  
Facsimile: (703) 683-1080  
REF/cjw  
A02.wpd  
August 20, 2007